

## **REMARKS**

### **Summary**

Claims 20 – 72 are currently pending. The Assignee amends claims 28, 49, and 70. The Assignee also adds new claims 73 – 81. No new matter has been added as a result of these amendments or new claims.

### **35 U.S.C. § 112**

Claims 28 and 49 were rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite. Claims 28 and 49 are amended to change the phrase “computer program” to “computer executable program.” As suggested in the Office Action, this amendment remedies the § 112 ¶ 2 rejection. Accordingly, the Assignee respectfully requests withdrawal of the § 112 rejection.

### **Double Patenting**

Claims 20, 36, 42, and 67 are rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Pat. No. 6,317,718 (“the ‘718 patent”). Claims 28 and 49 are rejected under the judicially created doctrine of obviousness-type double patenting over claim 9 of the ‘718 patent. As the Examiner has not yet identified allowable claims in the present application, the Assignee respectfully requests that the Examiner hold the double patenting rejection in abeyance until allowable claims in the present application have been identified and compared with claims 1 and 9 of the ‘718 patent.

### **35 U.S.C. § 103 – Bouve-Stewart Combination**

Claims 20-26, 28-34, 36, 37-40, 42-47, 49-54, 56-59, 61-65, 67-68, and 70-71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bouve et al. (U.S. Pat. No. 5,682,525), in view of Stewart (U.S. Pat. No. 5,835,061).

The Assignee respectfully submits that the Office Action does not address all the limitations of the rejected claims. In particular, at least two limitations are not addressed in the rejections. Accordingly, a prima facie case of obviousness is not made out by the rejection. First, independent claims 20, 28, 36, 49, 56, 61, and 67 each include a limitation directed to “transmitting the physical location of the user and the user profile to a retailer-based agent including a computerized network of information having identifications of physical locations of retailers and items of merchandise available for purchase at the retailers.” Independent claim 70 is amended to include a similar limitation of transmitting user profile information to a retailer

agent. The Office Action does not address this limitation and fails to indicate whether it is taught or suggested by the cited references.

Second, independent claims 20, 28, 36, 49, 56, 61, and 67 each include a limitation to a customized offer or to purchasing information based upon a user profile and the result of a query. Independent claim 70 is amended to include an offer for sale based in part on the result of a query. While the Office Action asserted that Stewart taught a customized offer based upon a user's shopping history, the Office Action does not show how the cited references teach or suggest a customized offer *based upon the result of a query*. For the foregoing reasons, the Assignee respectfully requests that the rejection be withdrawn and any subsequent office action be made non-final.

Upon examination of the Bouve-Stewart combination, the Assignee respectfully submits that this combination does not teach the above noted limitations. With respect to the transmitting limitation, Stewart, for example, does not transmit a user profile to a retailer-based agent. A user profile may be based on information about the user's past activities, as well as on current real-time situations. (See the Specification, Paragraphs [0266] and [0274]). In Stewart, information providers store on their own databases a user profile based on the user's past history with each respective information provider (Stewart, col. 6, lines 50-57, 63-65). An information provider in Stewart with no past history with a user may not have access to a user profile for that user. The claimed invention, on the other hand, transmits the user profile to the retailer-based agent, allowing the query, and customized offer of an item of merchandise sold by a retailer based on the result of that query, to be based on the user's profile even where that retailer had no prior history with the user. Bouve similarly does not disclose transmitting a user profile to a retailer-based agent. There is no teaching or suggestion to modify Bouve or Stewart to transmit the user profile as claimed.

With respect to the limitation directed to a customized offer based on the result of a query, the result of the query identifies a retailer proximate to the user selling an item of merchandise associated with the item of merchandise the user desires to purchase. As noted in the Office Action, Bouve does not disclose a customized offer. Stewart discloses a customized message based on the user profile or on the location of an access point. (Stewart, col. 8, lines 12-14). Stewart also discloses an information provider that books a travel itinerary for a user based

on the user profile stored in that information provider's memory. (Stewart, col. 6, line 50 – col. 7, line 5). Stewart does not disclose a customized offer based on the user profile *and the result of a query*. There is no suggestion or teaching to modify Stewart so that the customized offer is also based on the query result as claimed.

For the foregoing reasons, the Assignee respectfully submits that claims 20-26, 28-34, 36, 37-40, 42-47, 49-54, 56-59, 61-65, 67-68, and 70-71 are patentable over the combination of Bouve and Stewart, and respectfully requests withdrawal of the § 103 rejection.

### **35 U.S.C. § 103 – Bouve-Stewart-Bianco Combination**

Claims 27, 35, 41, 48, 55, 66, 69, and 72 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bouve et al. (U.S. Pat. No. 5,682,525), in view of Stewart (U.S. Pat. No. 5,835,061), further in view of Bianco (U.S. Pat. No. 5,047,416).

As discussed above, the combination of Bouve and Stewart does not teach all the limitations of claims 20, 28, 36, 42, 49, 61, 67, and 70, upon which claims 27, 35, 41, 48, 55, 66, 69, and 72 respectively depend. The addition of Bianco does not cure this deficiency. Bianco does not disclose transmitting the user profile to a retailer-based agent including a computerized network of information having identifications of physical locations of retailers and items of merchandise available for purchase at the retailers. Bianco does not disclose a customized offer for sale based on the result of a query.

For the foregoing reasons, the Assignee respectfully submits that claims 27, 35, 41, 48, 55, 66, 69, and 72 are patentable over combination of Bouve, Stewart, and Bianco, and respectfully requests withdrawal of the § 103 rejection.

### **Conclusion**

The asserted combinations of Bouve-Stewart and Bouve-Stewart-Bianco fail to teach or suggest the claimed subject matter. Assignee therefore respectfully requests withdrawal of the rejections and allowance of the claims. Further, as the Office Action fails to address all the limitations of the claims, the Assignee respectfully requests that any subsequent rejection be made non-final. The Examiner is invited to call the undersigned at the telephone number listed below if a telephone conference would expedite allowance of the application.

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Respectfully submitted,

A handwritten signature in cursive script, reading "Rickard K. DeMille". The signature is written in dark ink and is positioned above a horizontal line.

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